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REMARKS

While reviewing the claims in preparation for the current response, Applicant noticed a typographical error in claim 16. As such, Applicant has amended claim 16 to correct the typographical error.

ELECTION

The Examiner identified two groupings of claims. Group I contains claims 16-32 and Group II contains claims 1-15. Applicant elects, with traverse, Group II, claims 1-15.

TRAVERSAL REMARKS

The Examiner asserted that Groups I and II are distinct because "the combination as claimed does not require the particulars of the subcombination as claimed for patentability." Specifically, the Examiner stated that "invention I[] comprises an MRI system...[that] does not require the specific GUI as disclosed in invention II." However, this is simply not the case.

The Examiner asserted that "[i]nventions I and II are related as combination and subcombination" and that "the subcombination has utility by itself or in other combinations." However, MPEP §806.05(c) is clear that "[w]here the relationship between the claims is such that the separately claimed subcombination Bsp constitutes the essential distinguishing feature of the combination ABsp as claimed, the inventions are not distinct and a requirement for restriction must not be made, even though the subcombination has separate utility."

The Examiner asserted that the combination "comprises of an MRI system" and then listed the claimed components of an MRI system without addressing the claimed GUI. Then, as the basis for contending that the subcombination is NOT essential to the combination, the Examiner stated that the MRI system does not require the specific function of the GUI disclosed in invention I. However, for the Examiner's contention to be correct, claims 16 and 25 must be novel without the elements of the claims that call for the GUI. However, Applicant does not contend that an MRI apparatus and a method for acquiring medical images are patentable without the details of the subcombination. Therefore, since "there is no evidence that combination ABsp is patentable without the details of Bsp, restriction should not be required." *Id.* As such, Applicant requests rejoinder of the claims.

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As further evidence of the improper nature of the current restriction, the Examiner's procedural basis for the Restriction Requirement was also incomplete and unsustainable. The Examiner failed to meet the very requirements cited by the Examiner for a proper Restriction. Specifically, the Examiner cited MPEP §806.05(c), yet did not follow the guidance of this section. Section 806.05(c) states that "[i]n order to establish that combination and subcombination inventions are distinct, two-way distinctiveness must be demonstrated." (Emphasis added). Therefore, "[t]o support a requirement for restriction, both two-way distinctness and reasons for insisting on restriction are necessary, i.e., separate classifications, status, or field of search." MPEP §808.02. However, the Examiner has not demonstrated that (1) two-way distinctness is present between the combination and subcombination, and (2) that there is a reason for insisting on restriction, such a separate classification, status, or field of search.

With respect to the former requirement, the Examiner asserted that "invention I[] comprises an MRI system...[that] does not require the specific GUI as disclosed in invention II." However, this is simply not the case. Upon a proper review of the claims as a whole, it is readily apparent that the claims of both Groups I and II explicitly call for a GUI. See claims 16, 18, 20, 21, 22, 23, 24, 25, 26, 27, 29, 30, and 32.

The Examiner correctly identified that claim 16 does call for "an MRI system." However, the remainder of the claim was ignored. Claim 16 clearly calls for "a computer programmed to: (A) receive a launch MR application command; (B) launch an MR application; (C) receive a number of application step identifiers; (D) display a GUI on a console, the GUI having a number of tabs equal to the number of identified application steps; (E) initiate a localizer scan for at least one localizer and display a status of the localizer scan on the GUI; (F) receive a prescription command and acquire MR images in response to the received prescription command for an application step; and (G) receive another prescription command and acquire MR images in response to the received another prescription command for another application step." (Emphasis added).

Similarly, claims 25-32 also call for a specific GUI. However, the Examiner asserted that invention I, including claim 25, "does not require the specific functions of GUI as disclosed for invention II." The Examiner's assertion is simply not accurate. Though not cited by the Examiner, all claims explicitly call for, and thereby "require," a GUI. The Examiner cannot pick and choose elements of the claims and ignore others. The Examiner's assertions that invention I[] comprises an MRI system...[that] does not require the specific GUI as disclosed in invention II" erroneously ignores elements of claims 16, 18, 20, 21, 22, 23, 24, 25, 26, 27, 29, 30, and 32. Therefore, upon proper review of the whole claim, and contrary to the Examiner's

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assertion, it is readily apparent that claims 16-24 do in reality actually require a GUI and, as will be shown, the GUIs each have functionality that is not believed to be patentably distinct from one another.

Not only do the claims of both Group I and Group II expressly include a GUI, but the functionality of the claimed GUIs is clearly related. For example, claim 1 of Group II, in part, calls for "a plurality of modularizing selectors configured to facilitate workflow through an imaging application." On the other hand, claim 25 of Group I calls for "displaying a GUI for prescribing an imaging session, the GUI having a number of vertically aligned modularizing tabs corresponding to the number of prescription steps" (emphasis added). How would these searches differ? It appears to Applicant that the Examiner has ignored the functional similarities in these elements of the claims in constructing the current Restriction. Simply, claim 1 calls for a GUI with features to facilitate workflow through an imaging application and claim 25 calls for a GUI having features for navigating through a number of steps of an imaging application. While the language of the claims is not identical, Applicant believes that a GUI for navigating through a number of steps of an imaging application is not patentably distinct from the functionality of a GUI for facilitating workflow through an imaging application. Therefore, the Examiner's assertion that invention I, including claim 25, "does not require the specific *functions* of GUI as disclosed for invention II" is incorrect (emphasis added).

For at least these reasons, the Examiner has failed to establish that the combination as claimed does not require the particulars of the subcombination. As such, the Examiner has failed to meet the very requirements cited by the Examiner for a proper Restriction. See MPEP §806.05(c). The Examiner also failed to demonstrate two-way distinctiveness as required under MPEP §808.02.

With respect to MPEP §808.02's requirement that there is a reason for insisting on restriction, such a separate classification, status, or field of search, the Examiner attempted, but failed to identify that "the product as claimed can be used in a materially different process of using that product." Manual of Patent Examining Procedure §806.05(h) states that the burden is on the Examiner to provide an example. In this case, the Examiner has not provided a feasible example of any kind. Rather the Examiner summarily concluded without any support that "[t]he GUI of invention II is applicable to non-medical imaging apparatus." This is simply inaccurate in that claims 1, 10, 16, and 25 all clearly call for a "medical imaging session," "MR imaging scan," "MRI imaging," and "medical images," respectively. Therefore, the claimed invention and all Groups are particularly limited to medical imaging.

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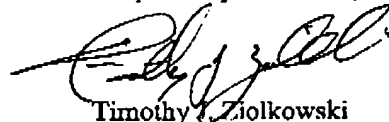
Additionally, the Examiner asserted that "[t]he GUI allows user input during the medical imaging process, but the user input is not required." While Applicant does not disagree with the Examiner's statement, Applicant does not believe the statement, or the validity thereof, is relevant to whether the identified groups are related as combination and subcombination. That is, whether any MRI process or portion thereof is automated does not in any way establish the distinctiveness of the identified groups as combination and subcombination or establish a reason for insisting on the restriction.

As such, under MPEP §806.05(h), "[i]f the Applicant either proves or provides a convincing argument that the alternative use suggested by the Examiner cannot be accomplished, the burden is on the Examiner to support a viable alternative use or withdraw the requirement." Accordingly, since the Examiner's position is incorrect and unsupportable, Applicant respectfully requests rejoinder of Groups I and II.

In summary, restriction between Groups I and II is improper. In proffering the restriction, the Examiner failed to consider the claims as a whole and, in fact, has ignored elements of the claims in proffering the restriction. There is no evidence that the combination is patentable without the details of the subcombination. Therefore, MPEP §806.05(c) is clear that a restriction cannot be required. The Examiner has failed to meet the burdens imposed in sustaining a restriction. Therefore, Applicant requests prompt rejoinder of Groups I and II and a substantive action on the merits.

The Examiner is invited to call the undersigned to discuss this Restriction Requirement or any other matters regarding this application.

Respectfully submitted,



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